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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,616	01/11/2001	Edith Helen Stern	YOR920000604US1	2797
35526	7590	06/13/2005	EXAMINER	
DUKE. W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			HAVAN, THU THAO	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/758,616

**Applicant(s)**

STERN ET AL.

**Examiner**

Thu Thao Havan

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/11/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/11/01.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**Detailed Action**

***Drawings***

The Examiner accepts the drawings filed on May 11, 2001.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-51** are rejected under 35 U.S.C. 102(e) as being anticipated by Stanley et al. (US application no. 2002/0111888).

Re claims **1, 14, and 34**, Stanley teaches preparing a tax return (abstract) comprising the steps of: subscribing to a financial recording service provider (para. 0013); receiving tax data from the financial recording service provider and validating the tax data received from the financial recording service provider (para. 0014); and, submitting the validated tax data (para. 0017). *In other words, Stanley discloses automated tax return preparation. The taxpayer is interviewed and his information is collected from financial institutions. In that the tax software retrieves tax data directly from the financial institutions. Overall, Stanley's application enables an automated tax return system to prepare tax returns in advance with minimal user assistance.*

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Re claims **2, 9-10, 15, 22-23, 35, and 40**, Stanley teaches validated tax data is submitted to a tax authority (para. 0053). *In other words, Stanley validates tax data by using an EIN as a primary check for an authorized financial institution.*

Re claims **3, 16, 24, 36, and 44-45**, Stanley teaches validated tax data is submitted to the financial recording service provider (para. 0014).

Re claims **4, 11, 17, 25, and 37**, Stanley teaches validated tax data is submitted to a tax return preparation service (para. 0030, 0131, and 0132).

Re claims **5, 8, 18, 21, 38, and 42-43**, Stanley teaches updating the client taxpayer's tax data with additional financial data (para. 0044 and 0129). *In other words, Stanley updates as needed of the taxpayers' information.*

Re claims **6, 19, and 39**, Stanley teaches preparing a tax return (abstract) comprising the steps of: receiving tax data associated with a client taxpayer from an institution (para. 0030); seeding a tax return with the tax data received from the institution (para. 0014-0015); and, validating the tax data (para. 0017).

Re claims **7, 20, and 41**, Stanley teaches client taxpayer may validate the tax data in the tax return (para. 0014-0015).

Re claims **12 and 46**, Stanley teaches validating the additional tax data is performed by the institution (para. 00131-132).

Re claims **13 and 47**, Stanley teaches billing the client taxpayer subscriber (para. 0034). *In other words, Stanley discloses preparing the taxpayer information for a fee, which corresponds to billing the taxpayer.*

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Re claims **26, 30, and 48**, Stanley teaches preparing a tax return (abstract), comprising the steps of: receiving tax data from an institution (para. 0030); and, indexing the tax data associated with a client taxpayer subscriber (para. 0007 and 0132). *In other words, Stanley discloses a taxpayer maintains a plurality of relationships with a plurality of financial institutions. A financial institution is any entity that provides tax information about taxpayers, and a taxpayer has a relationship with a financial institution if the financial institution provides tax data about that taxpayer. In addition, Stanley discloses filing tax data that corresponds to indexing the tax data associated with a client taxpayer subscriber.*

Re claims **27, 31, and 49**, Stanley teaches selectively providing access to the tax data associated with the client taxpayer subscriber (para. 0131-132).

Re claims **28, 32, and 50**, Stanley teaches access to the tax data is provided to an authorized requester (para. 0030). *Stanley retrieves information of taxpayer by a taxing authority.*

Re claims **29, 33, and 51**, Stanley teaches authorized requester is one of the client taxpayer subscriber, a government tax authority, or a third party tax return preparation service (para. 0030). *In other words, Stanley discloses the taxpayer wants a prepared tax return that she can submit to a taxing authority, such as the Internal Revenue Service in the United States, or to other various national, state and local governments throughout the world.*

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Wagner, US application no. 2003/0233296, teaches requisition for tax data;

Miller, US patent no. 6,697,787, is directed to collecting tax data;

Dang et al., US Publication No. 2003/0105686, discloses transmitting tax related data to a selected financial institution. However, the filing date is not valid but this is a good reference to be cited as prior art; and

Campbell, US publication no. 2003/0233297, teaches managing tax information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH  
6/8/2005

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